

27, and 34-38 have been amended to expressly recite the method steps. As discussed below, new matter has not been added.

***The Consent of Assignee***

The Examiner noted that the person who signed "the submission establishing ownership interest" is not recognized as an officer of the assignee. There was no "submission establishing ownership interest" filed so it is assumed the Examiner is referring to the Consent of Assignee. A new Consent of Assignee is submitted herewith including an averment that the person who signed the document, Dr. Reinhold Nowak, is authorized to act on behalf of the assignee, 3M ESPE AG. A copy of the latest change of name is attached to Dr. Nowak's Declaration.

***The Rejection Under 35 U.S.C. § 251 as Being Based Upon New Matter is in Error***

For the first time in the protracted prosecution of this application, the Examiner rejected Claims 6-10, 14-16, 18, 20, 22, 25, 28, and 34-38 under 35 U.S.C. § 151 as being based on new matter added to the patent for which reissue is sought. Similarly, for the first time in the protracted prosecution of this application, the Examiner rejected the same claims under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time the application was filed. The rejection under 35 U.S.C. § 112 is asserted to be because of new matter. According to the

Examiner, the method of dispensing is the alleged new matter. These two rejections are respectfully traversed.

Claims 6-10, 14-16, 18, 20, 22, 25, 28, and 34-38 are all drawn to the method of use of the apparatus claimed in Claims 1-5, 11-13, 17, 19, 21, 23, 26, 25, and 29-33, respectively. None of what is claimed is new matter.

First, the Examiner's attention is directed to, e.g., Column 3, lines 45-55, and Column 4, lines 15-23, where the method of use of the device of the invention is described. At Column 3, lines 45-55, it is taught that:

In operation of the device, a film tube 15, which is filled with a substance to be dispensed, is inserted into the cartridge 1 from the front end thereof until the peripheral portion 19 of the ring flange abuts the front edge 5 of the cartridge 1. ...

The cap 2 is then placed on the cartridge 1 with its end portion 7 surrounding the end portion 4 of the cartridge 1 ....

At Column 4, lines 15-23, it is taught that:

When pressure is subsequently exerted on the rear end of the tube 15 by the advancing piston 3, this pressure is transmitted forward through the tube 15 ....

As the Examiner is aware, the purpose of the description requirement of § 112 is to assure that the applicant was in full possession of the claimed subject matter on the date of the filing of the application. *Fields v. Conover*, 443 F.2d 1386, 170 USPQ 276 (CCPA 1971). To comply with the description requirement, the specification must clearly convey to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. *In re*

*Wertheim*, 541 F.2d 257, 262, 191 USPQ 90 (CCPA 1976). Section 112 is incorporated in § 120 to insure that the applicant was in full possession of the claimed subject matter on the filing date of the parent application. *In re Edwards*, 568 F.2d 1349, 1351, 196 USPQ 465, 467 (CCPA 1978). Similarly, the provisions of § 112 are incorporated in § 251. *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641, 1651 (Fed. Cir. 1998), citing *In re Amos*, 953 F.2d 613, 618, 21 USPQ2d 1271, 1275 (Fed. Cir. 1991).

It is not necessary to describe the subject matter of the later claim *in haec verba*. *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795 (CCPA 1971). Further, the disclosure of the later claimed aspects of the invention can be inherent. *Kennecott Corp. v. Kyocera Int'l, Inc.*, 835 F2d 1419, 5 USPQ2d 1194 (Fed. Cir. 1987), cert. denied, 486 U.S. 1008 (1988). The claims of the patent in suit in *Kennecott*, which issued on a CIP application, were entitled to the benefit of the filing date of the parent application. The court held that the disclosure in a subsequent patent application of an inherent property of a product does not deprive that product of the benefit of an earlier filing date. Nor does the inclusion of a description of that property in later-filed claims change this reasonable result. "By disclosing in a patent application a device that inherently performs a function, operates according to a theory, or has an advantage, a patent applicant necessarily discloses that function, theory, or

advantage even though he says nothing concerning it." *In re Reynolds*, 443 F.2d 384, 389, 170 USPQ 94, 98 (CCPA 1971) quoting *Technicon Instruments Corp. v. Coleman Instruments, Inc.*, 225 F.Supp. 630, 640-41, 150 USPQ 227, 236 (N.D. Ill. 1966), *aff'd*, 385 F.2d 391, 155 USPQ 369 (7th Cir. 1967). See, also, *Therma-Tru Corp. v. Peachtree Doors, Inc.*, 44 F.3d 988, 33 USPQ2d 1274 (Fed. Cir. 1995); *In re Smythe*, 480 F.2d 1376, 1384, 178 USPQ 279, 285 (CCPA 1973).

In the instant case, the very description of the device of the product claims and its mode of operation is a description of the method of use of Claims 6-10, 14-16, 18, 20, 22, 25, 28, and 34-38. These rejections are, therefore, in error and should be withdrawn.

***The Rejection Under 35 U.S.C. § 251 as Being an Improper Recapture of Broadened Claimed Subject Matter Surrendered in the Original Application is in Error***

The Examiner rejected Claims 11-38 under 35 U.S.C. § 251 as allegedly being an improper recapture of broadened claimed subject matter surrendered in the application for patent upon which the present reissue is based. For the first time, in this Action, the Examiner asserted that "the supporting surface is part of the structure used to define the 'gap' or 'play'". This rejection is again respectfully traversed.

As is well-known, recapture occurs when an applicant attempts to obtain in a reissue claims which were cancelled or otherwise relinquished during prosecution of the original patent. It is clear from the case law that an applicant may

not omit a limitation which was relied upon for patentability. See e.g., *Hester Industries Inc. v. Stein Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *Ball Corp. v. United States*, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984); and *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

The recent case of *Dethmers Mfg. Co. v. Automatic Equipment Mfg. Co.*, 60 USPQ2d 1929, 1932 (Fed. Cir. 2001) is instructive. In *Dethmers*, the court discussed a Reissue Declaration which said:

The first error that arose in the claims of the patent was the inclusion of the subject matter of [application] claims 2 and 3 in the amended base [application] claim 7. This subject matter was not material to the invention. This subject matter had already been disclosed in Johnson's own prior patent which was cited by the Examiner to reject [application] claims 2 and 3. Furthermore, the Examiner stated that the basis for allowability was that the prior art failed to teach [another limitation]. This structure has nothing to do with the subject matter of [application] claims 2 and 3. Accordingly, Johnson claimed less than he had the right to claim when the subject matter of [application] claims 2 and 3 and related language were included in amended [application] base claim 7.

The PTO allowed the reissue claims based, *inter alia*, on that statement.. Neither the defendant nor the district court challenged that action. The Federal Circuit treated it as given. *Id.* at 1935.

The instant case is almost identical to the *Dethmers* fact situation:

Original Claim 3 of the grandparent application read:

The device of claim 2, wherein said housing has a ring supporting surface, said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually

facing surfaces when said ring abuts said engaging portion of the cap and the peripheral portion of said ring abuts said supporting surface.

Thus, Claim 3 essentially had two limitations:

1. said housing has a ring supporting surface; and
2. said end portions of the housing and the cap having such axial dimensions that a play is retained between their mutually facing surfaces when ....

In the Office Action of June 2, 1995, the Examiner rejected Claims 1, 2, and 4 under 35 U.S.C. § 102(b) as anticipated by a reference (U.S. Patent No. 3,815,787) to Spies. The Examiner explained:

Spies shows a device for emptying a tube (14) comprising a ring (50), housing (16), a piston (40), cap (64), dispensing opening (92), annular engaging portion (70) and supporting surface (24). [Emphasis added.]

At the same time, the Examiner indicated the allowability of Claim 3.

It is clear that it was limitation 2 which was relied upon for patentability and not limitation 1. In the Office Action of June 2, 1995, the same Examiner said that the prior art Spies reference teaches a "supporting surface (24)". Thus, that limitation was not relied upon for patentability and may, under the prevailing case law, be omitted.

Thus, the very limitation which the Examiner now asserts is critical to the claims is a limitation taught by the prior art and which the same Examiner considered not to be critical to patentability in the prosecution of the original patent.

The Examiner's new contention that the "the supporting surface is part of the structure used to define the 'gap' or

'play"', is belied by the clear language of the claims of the original patent, e.g., the instant Claim 1 which says, in relevant part (separate paragraphs created here for ease in understanding) :

[A] a gap remains between [1] mutually facing surfaces of said end portions of the housing and [2] the cap

[B] when said housing, cap and tube are assembled with said ring abutting said engaging portion of the cap and the peripheral portion of said ring abutting said supporting surface of said housing.

Claim 1 itself defines the gap as being formed by (1) mutually facing surfaces of end portions of the housing and (2) the cap, when the device is assembled. Assembly involves the ring abutting the engaging portion of the cap and the peripheral portion of the ring abutting the supporting surface of the housing. Nowhere do any of the claims or the specification require that the supporting surface define the gap or play. Clause [B] merely describes proper assembly to achieve a desired result. Clause [A] defines the structure which results in the gap or play.

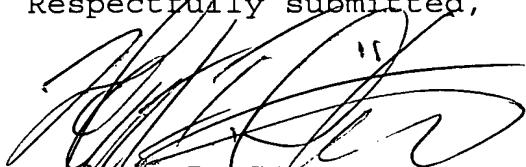
Considering the foregoing, this rejection is clearly erroneous and should be withdrawn.

Since all the claims are clearly in condition for allowance and are free of the prior art, an early Notice of Allowance is in order and the same is most earnestly solicited. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated.

It is respectfully requested that this paper be considered as a Petition for an Extension of time sufficient

to effect a timely response and any necessary fees be charged, or any overpayment in fees be credited, to the Deposit Account of Crowell & Moring LLP, Account No. 05-1323 (Docket No. 1860/48111RE).

Respectfully submitted,



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APPENDIX

--6. (Amended) A method of emptying a film tube which contains a substance to be dispensed using the device of Claim 1, comprising inserting said film tube in said cylindrical housing between said piston and said cap and exerting pressure on said piston.

7. (Amended) A method of emptying a film tube which contains a substance to be dispensed using the device of Claim 2, comprising inserting said film tube in said cylindrical housing between said piston and said cap and exerting pressure on said piston.

8. (Amended) A method of emptying a film tube which contains a substance to be dispensed using the device of Claim 3, comprising inserting said film tube in said cylindrical housing between said piston and said cap and exerting pressure on said piston.

9. (Amended) A method of emptying a film tube which contains a substance to be dispensed using the device of Claim 4, comprising inserting said film tube in said cylindrical housing between said piston and said cap and exerting pressure on said piston.

10. (Amended) A method of emptying a film tube which contains a substance to be dispensed using the device of Claim 5, comprising inserting said film tube in said cylindrical

housing between said piston and said cap and exerting pressure on said piston.

14. (Amended) A method of emptying a film tube which contains a flowable substance using the device of Claim 11, comprising inserting said film tube in said housing between said piston and said cap and exerting pressure on said piston.

15. (Amended) A method of emptying a film tube which contains a flowable substance using the device of Claim 12, comprising inserting said film tube in said housing between said piston and said cap and exerting pressure on said piston.

16. (Amended) A method of emptying a film tube which contains a flowable substance using the device of Claim 13, comprising inserting said film tube in said housing between said piston and said cap and exerting pressure on said piston.

18. (Amended) A method of emptying a film tube which contains a flowable substance using the device of Claim 17, comprising inserting said film tube in said housing between said piston and said cap and exerting pressure on said piston.

20. (Amended) A method of dispensing a flowable substance using the assembly of Claim 19, comprising inserting said film tube in said space and exerting pressure on said piston.

22. (Amended) A method of dispensing a flowable substance using the assembly of Claim 21, comprising inserting said film tube containing said flowable substance in said space and exerting pressure on said piston.

25. (Amended) A method of dispensing a flowable substance using the assembly of Claim 23, comprising exerting pressure on said piston.

27. (Amended) A method of dispensing a flowable substance utilizing the assembly of Claim 26, wherein said flowable substance is contained in said film tube, said method comprising disposing said film tube in said space and exerting pressure on said piston.

34. (Amended) A method of dispensing a flowable substance using the assembly of Claim 29, comprising exerting pressure on said piston.

35. (Amended) A method of dispensing a flowable substance using the assembly of Claim 30, comprising exerting pressure on said piston.

36. (Amended) A method of dispensing a flowable substance using the assembly of Claim 31, comprising exerting pressure on said piston.

37. (Amended) A method of dispensing a flowable substance using the assembly of Claim 32, comprising exerting pressure on said piston.

38. (Amended) A method of dispensing a flowable substance using the assembly of Claim 33, comprising exerting pressure on said piston.--